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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212797
Party	Defendant McDAVID, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Sisco Textiles NV, a Netherlands limited liability company.)	
)	
Opposer,)	Opposition No.: 91,212797
v.)	
)	
McDavid, Inc.)	
)	
Applicant.)	
)	
Serial No.: 85/665,732)	
Filed: June 29, 2012)	
Mark: FIRST ON. LAST OFF.)	

ANSWER TO NOTICE OF OPPOSITION

McDavid, Inc., Applicant in the above-identified Opposition, hereby responds to the Notice of Opposition filed by Sisco Textiles NV, a Netherlands limited liability company, opposing registration of the mark FIRST ON LAST OFF, Application Serial No. 85/665,732.

In response to the Notice of Opposition, Applicant states as follows:

1. Opposer Sisco Textiles NV, directly and through its predecessors and licensees in interest (collectively, "Opposer"), has developed, marketed and sold apparel, swimwear, wetsuits and other athletic gear, accessories and footwear, and sponsored athletic events, including surfing events, under a number of marks, including the well known O'NEILL® mark, an iconic brand that was first used in the United States at least as early as 1952.

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Notice of Opposition and, therefore, denies the same.

2. Opposer uses the FIRST IN LAST OUT® mark for products and services. Products offered under Opposer's FIRST IN LAST OUT® mark are distributed, sold and promoted in the United States, including in O'NEILL retail stores, in catalogues, and on the www.oneill.com web site. Opposer also uses its FIRST IN LAST OUT® mark for retail store and online retail store services.

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 2 of the Notice of Opposition and, therefore, denies the same.

3. Opposer owns a valid, subsisting, uncanceled and unrevoked federal trademark registration for a FIRST IN LAST OUT®, Registration No. 4292847, which was filed on January 13, 2011 and registered on February 19, 2013 for use in connection with the following goods and services in International Classes 9, 16, 18, 25 and 35, including athletic wear:

Class 9: Sunglasses; spectacles; diving suits; protective clothing for aquatic pursuits, namely, diving suits

Class 16: Photographs; books in the field of surfing, watersports and skiing

Class 18: Leather and imitation leather and goods made thereof, namely, travel bags, shoulder bags, handbags, purses, and wallets; bags, namely, backpacks, rucksacks, duffle bags, fanny packs, athletic bags, shoulder bags, handbags, book bags, shopping bags of leather, imitation leather and textile; travel bags; sports bag; beach bags; rucksacks and shopping bags made of leather and canvas; umbrellas and parasols; pocket wallets and purses

Class 25: Clothing, namely, shirts, t-shirts, pants, jackets, shorts, board shorts, swimwear, swimming trunks, swimsuits, sweatshirts, sweaters, and socks; belts; footwear; leisure shoes; slippers; sandals; headgear, namely, caps, cap peaks and hats; sports and leisure wear, namely, wetsuits and dry suits; skiwear, namely, coats, jackets, and pants; clothing for surfing, windsurfing and water skiing, namely, wetsuits; wet and dry suits for diving and underwater swimming

Class 35: Retail store services and computerized on-line ordering services featuring clothing, such as sports and leisure clothing, and water sports goods; marketing and advertising; business management in the field of support of the commercialization of products and services within the framework of "e-commerce"; administrative processing of electronically placed purchase orders; logistic management for business organization purposes in the field of retail store sales services and computerized on-line ordering services featuring clothing, namely, sports and leisure clothing, and water sports goods

A true and correct copy of the TSDR and Assign Status printout for this registration is attached hereto as Exhibit A.

ANSWER: Applicant acknowledges the existence of Registration No. 4292847 and the contents of that Registration. Application is without knowledge or information sufficient to

form a belief as to the truth of the remaining allegations contained in Paragraph 3 of the Notice of Opposition and, therefore, denies the same.

4. Opposer has used its FIRST IN LAST OUT® mark in interstate and foreign commerce in connection with retail store services since at least as early as July 2009 and in connection with clothing since at least as early as November 25, 2010, each well prior to the filing date of the opposed intent-to-use application at issue in this proceeding.

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Notice of Opposition and, therefore, denies the same.

5. Opposer has expended substantial time and effort in promoting its FIRST IN LAST OUT® mark. Through continuous and exclusive use, Opposer's FIRST IN LAST OUT® mark has become identified with Opposer's products- including protective gear, clothing, footwear and headgear- and with Opposer's retail store services. Opposer has developed substantial goodwill in its federally registered FIRST IN LAST OUT® mark.

ANSWER: Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 5 of the Notice of Opposition and, therefore, denies the same.

Applicant's Trademark Application

6. On June 29, 2012, well after Opposer commenced use of its FIRST IN LAST OUT® mark in the United States, after Opposer had filed its use-based trademark application in the United States, and after Applicant's application had been allowed, Applicant filed an intent-to-use application for the designation FIRST ON. LAST OFF., Serial No. 85/665,732. The opposed application covers the following goods in International Classes 10, 25 and 28:

Class 10: orthopedic support pads and braces for anatomical joints and muscles, orthopedic articles, namely, braces, paddings, supports and cushions; support bandages for heat packs and ice packs, therapeutic warm and cold packs, elbow supports for medical use, wrist supports for medical use, orthopedic leg and upper thigh bandages and supports, elastic strip bandages, back supports for medical purposes, support for the lumbar vertebrae for medical use, shoulder supports for medical use, ankle supports for medical use, athletic ankle braces for medical use; thigh supports for medical use; support corsets for therapeutic use; bandages for anatomical joints; braces for limbs and joints for medical use; compression bandages; compression socks for medical or therapeutic use; elastic bandages; heating pads for medical purposes; ice bags for medical purposes; medical ice packs; non-medicated compresses;

orthopedic braces; orthopedic cushions and padding; orthopedic support bandages; orthopedic supports; support bandages; supports for general medical use; therapeutic hot and cold therapy packs; therapeutic hot and cold compression wraps; thermal packs for first aid purposes

Class 25: clothing, namely, shirts, shorts, tights, athletic support tops, tops, girdles, compression shirts for non-medical purposes, compression tops for non-medical purposes, compression shorts for non-medical purposes, compression pants for non-medical purposes, athletic sleeves, leggings, wrist bands, heel cuffs, elbow cuffs, hats, gloves, undergarments, headwear and footwear

Class 28: elbow protectors for athletic use; wrist protectors for athletic use; thigh protectors for athletic use

ANSWER: Applicant admits that it filed Application No. 85/665,732 and the contents of that Application. Applicant is without knowledge as to the remaining allegations contained in Paragraph 6 of the Notice of Opposition and, therefore, denies the same.

7. Based on the goods and services for which Applicant seeks to register the applied for designation, Applicant's goods will be competitive with or directly related to the products and services Opposer has offered and sold under its FIRST IN LAST OUT® mark.

ANSWER: Denied.

8. On information and belief, based on the goods for which Applicant seeks to register the applied-for designation, the goods Applicant intends to offer under the applied for designation will be sold and/or are likely to be sold or offered for sale through the same or overlapping channels of trade and/or in the same geographic locations, will be used and/or are likely to be used by the same or overlapping end users and will be used and/or are likely to be directed to the same or overlapping type of customers to whom Opposer markets, promotes and sells its products and services under its FIRST IN LAST OUT® mark.

ANSWER: Denied.

9. Applicant's applied-for designation appears confusingly similar in sight, sound, meaning and overall commercial impression to Opposer's FIRST IN LAST OUT® mark, which suggests an affiliation, association or sponsorship between Applicant and Opposer when there is none, and creates a likelihood of consumer confusion.

ANSWER: Denied.

FIRST CAUSE OF ACTION
(Likelihood of Confusion)

10. Opposer incorporates by reference and realleges as though fully set forth herein the allegations of paragraphs 1 through 9 of this Notice of Opposition.

ANSWER: Applicant incorporates by reference its responses to the allegations of paragraphs 1 through 9 of the Notice of Opposition.

11. The products set forth in the opposed application on their face overlap with and are directly related to the products and services Opposer has offered and sold using its FIRST IN LAST OUT® mark. Further, on information and belief, the products listed in the application will be sold and/or are likely to be sold or offered for sale through the same or overlapping channels of trade and/or in the same geographic locations, will be used and/or are likely to be used by the same or overlapping users, and will be used and/or are likely to be directed to the same or overlapping type of customers to whom Opposer markets, promotes and sells its products and services using its FIRST IN LAST OUT® mark.

ANSWER: Denied.

12. The opposed, applied-for designation is substantially similar in terms of sight, sound, meaning and overall commercial impression as Opposer's FIRST IN LAST OUT® mark, and thereby is confusingly similar to Opposer's FIRST IN LAST OUT® mark.

ANSWER: Denied.

13. The designation covered by the opposed application is likely to cause confusion, or to cause mistake or disparage or deceive by falsely suggesting a connection with Opposer and the products and services for which Opposer uses its FIRST IN LAST OUT® mark, when there is no such connection.

ANSWER: Denied.

14. Opposer believes it will be damaged by registration of the applied-for designation in violation of Sections 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Unless Applicant's application is denied, Applicant will unjustifiably reap the benefits of the goodwill attached to Opposer, its FIRST IN LAST OUT® mark and products and services, and Opposer will suffer irreparable damage and injury as a result of the confusion and false association that is likely to arise from the registration of opposed application.

ANWER: Denied

Applicant hereby denies each and every allegation contained in the Notice of Opposition which is not otherwise herein specifically responded to.

AFFIRMATIVE DEFENSES

For its affirmative defenses to the Opposition, Applicant asserts the following:

1. There is no likelihood of confusion, mistake or deception because, *inter alia*, Applicant's mark and the alleged marks of Opposer are not confusingly similar.
2. On information and belief, any use of Opposer's alleged marks specified in the Notice of Opposition move in a distinct line of commerce from the services of Applicant and no such similarity in the channels of trade has been alleged by Opposer.

WHEREFORE, Applicant respectfully prays that opposition to registration of its FIRST ON. LAST OFF., Application No. 85/665,732, be dismissed, that a Notice of Allowance be issued, and that Applicant be granted such other and further relief as the Board deems just and proper.

Respectfully submitted,
McDavid, Inc.

November 11, 2013

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CERTIFICATE OF SERVICE

I, Joseph T. Nabor, Attorney for the Applicant, hereby certify that a copy of the foregoing ANSWER TO NOTICE OF OPPOSITION was served by first class mail, postage prepaid, upon:

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on this 11th day of November, 2013.

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